

I. Amendments to the Specification

Please amend the specification by deleting the noted original paragraphs and replacing them with the following versions of the paragraphs.

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Page 1, lines 1-2:

~~This application contains subject matter protected by
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II. General Remarks Concerning This Response

Claims 1-7 and 9-22 are currently pending. In this response, no claims are amended; no claims are added; and no claims are canceled. Reconsideration of the claims is requested.

5 The Office action objected to the specification as having an improper copyright notice; the paragraph has been amended to present a proper copyright notice.

The Office action objected to the specification because "JAVA" was not properly noted as being a trademark, and the
10 Office action requested a substitute specification, which is being mailed separately from this response.

III. Rejections over JavaServer Pages™ Specification Vers. 1.1

The Office action has rejected all of the claims in some
15 manner in view of Pelegri-Llopert et al., *JavaServer Pages™ Specification Vers. 1.1*, Sun Microsystems, Inc., 08/18/1999 (JSP 1.1). The rejection is traversed.

Applicant respectfully asserts that Applicant completed and reduced to practice the claimed invention before the publication
20 of JSP 1.1 (August 18, 1999). A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Shane Claussen, an inventor of the present invention; the declaration was included with Applicant's previous response, and reconsideration of the declaration is kindly requested. The inventor declares that
25 Applicant's claimed invention was completed and reduced to practice prior to August 18, 1999. Exhibit "A" to the inventor's declaration is an IBM Invention Disclosure Form that disclosed Applicant's claimed invention. This Disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas
30 prior to August 18, 1999. The inventor's declaration under 37 C.F.R. § 1.131, therefore, removes JSP 1.1 from consideration as

prior art. Because JSP 1.1 should not be considered with respect to Applicant's claimed invention, the rejection fails to make a *prima facie* case of obviousness in rejecting the pending claims. Applicant respectfully asserts that the claims are allowable.

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IV. Arguments in support of Applicant's 1.131 Declaration

The Office action raises multiple issues with respect to Applicant's previously submitted declaration under 37 C.F.R. § 1.131, which the Office action describes as "ineffective".

10 The Office action states the following on pages 2 and 3:

Exhibit A is an IBM disclosure Form AUS8-1999-0688. Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. The proof is demonstrated with
15 satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include attached sketches, blueprints, photographs, reproduction of notebook entries, accompanying models, supporting statements by witnesses, interference
20 testimony, and/or prior submission to the USPTO of disclosure documents.

In view of the examples of support as explained above, it is the examiner's opinion that the evidence within Evidence A [sic] is insufficient proof that the Applicant's
25 invention was reduced to practice before the filing date of the JSP 1.1 (August 18, 1999) reference. Applicant identifies a problem and how one might solve it. Applicant lists a variety of examples including related art that tried to solve a similar problem, but does not show that it
30 actually existed and worked for its intended purpose (see page 2 of Exhibit A). Applicant appears to disclose relevant language in section 4 of Exhibit A; however actual reduction to practice requires a working example of the invention and the invention must be tested to ascertain that
35 it operates in the manner intended and accomplishes the goals it was developed to accomplish. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and
40 general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits

describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts", and thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29, (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964).

The Office action clearly shows a lack of understanding of the patent prosecution concept of "constructive reduction to practice". The Office action is objecting to the disclosure document as not providing sufficient evidence of a physical reduction to practice. It should be noted that the disclosure document provides evidence of a constructive reduction to practice in the same manner that the specification document of a patent application provides evidence of a constructive reduction to practice. Moreover, the disclosure document provides evidence of a conception of the invention prior to the effective date of the 08/18/1999-published reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application, as stated in 37 CFR 1.131.

The Office action either confuses the concepts of "derivation of work" with "reduction to practice" or implies that Applicant has confused the concepts when the Office action states:

Furthermore, Applicant's claim that he is named under "Acknowledgments" of the "'JavaServer Pages Specification' (8/18/1999)" does not serve as evidence of reduction to practice, as it does not indicate in what way and in what scope the inventor contributed to the disclosure.

Applicant did not make the statement about the "Acknowledgments" section in support of the concept of a reduction to practice. By including the statement about the "Acknowledgments" section of

the prior art reference in "Exhibit A", Applicant was bringing to the attention of the USPTO that the JSP 1.1 reference is derived from Applicant's own work. Applicant argues this issue in more detail hereinbelow.

5 The Office action also requests further information using the following statement:

 Applicant states that the deleted dates from Exhibit A are prior to August 18, 1999. Examiner points out that page 4 of the IBM disclosure cites a date of 12/99 for WebSphere.
10 An explanation of why the disclosure cites a date that is after the August 18th, 1999 date of Disclosure would be appreciated.

The date to which the Office action is referring is found in the
15 "Critical Questions" section of the disclosure document in "Question 3", which reads in part: "Is a sale, use in manufacturing, product announcement, or proposal planned?" The disclosure document shows that the "Yes" option for this question was selected. The disclosure document then contains the
20 following statement: "If Yes, identify the product if known and indicate the date or planned date of sale, announcements, or proposal and to whom the sale, announcement or proposal has been or will be made." In response, over multiple lines, the disclosure document reads:

25 WebSphere
 3.x
 JSPx or XSP
 12/1999
 IBM Internal

30 It is unclear why the Office action requests an explanation of the "12/1999" date. At a date prior to August 18, 1999, it was expected that the invention that was disclosed within the disclosure document would be included in an IBM product (IBM is
35 the assignee of the present invention) at a time approximately

around December 1999. The "12/1999" date is irrelevant with respect to the 08/18/1999 date of publication of the reference that has been used in a rejection of the present invention; it is a future date that is after the 08/18/1999 date. The fact that
5 the disclosure document mentions a date after the 08/18/1999 is irrelevant. The relevant facts are that the claimed invention was constructively reduced to practice at a date prior to the 08/18/1999 publication date as evidenced by the disclosure document, which was created prior to 08/18/1999; these facts are
10 declared as truthful by the inventor. Whether or not the present invention was actually included within the specified product at a date after the 08/18/1999 publication date is irrelevant.

The Office action also requests further information using the following statement:

15 Examiner requests Applicant to present any disclosures, publications, or sales information that have been cited in the IBM Invention Disclosure on pages 3-4 to conform with 37 CFR 1.105.

20 Applicant declines to provide further information at this time because Applicant asserts that the Office action's inclusion of a requirement under 37 CFR 1.105 for additional information is unreasonable for the following reasons and/or other reasons.

First, MPEP 704.11 states: "The criteria in 37 CFR 1.105 for
25 making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application." Applicant asserts that there is no issue or matter in the present application such that the examination of the present application would be assisted by additional
30 information. The Office action contains a statement in which it appears that the Office action considered the 12/1999 date to be relevant, but as explained above, the 12/1999 date is irrelevant.

Second, MPEP 704.11 states: "There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter."

Applicant asserts that there is no reasonable basis for the 1.105

5 request for information. The Office action contains a statement that shows confusion with respect to the outstanding relevant issues, particularly the dates that are relevant to the issue of the reduction to practice of the present invention and the publication date of a reference that partially forms the basis
10 for the pending rejection of the claims in the present patent application. The 12/1999 date that is mentioned in the disclosure document is a date when it was expected that the invention that was disclosed within the disclosure document would be included in an IBM product (IBM is the assignee of the present
15 invention) at a time approximately around December 1999. As noted above, whether or not the present invention was actually included within the specified product at a date after the 08/18/1999 publication date is irrelevant. The fact of whether or not there were "any disclosures, publications, or sales
20 information" related to this mentioned product is irrelevant and does not provide a reasonable basis for requesting such information.

Third, the statement in the Office action is misleading:

"Examiner requests Applicant to present any disclosures,
25 publications, or sales information that have been cited in the IBM Invention Disclosure on pages 2-3 ...". Applicant asserts that the disclosure document does not cite such information; the disclosure document requests that the inventor provide such information as is known to the inventor at the time that the
30 inventor creates the disclosure document, and the inventor did not cite "any disclosures, publications, or sales information."

Fourth, the fact that there may have been some intention on the part of the assignee to prospectively include the present invention in a future product does not necessarily imply that the present invention was described within "any disclosures, publications, or sales information" in any useful manner in any additional information within the relevant time frame, i.e. around the 08/18/1999 publication date of the applied reference.

Fifth, the disclosure document clearly contains information that negates the 1.105 requirement for additional information.

The disclosure document clearly cites "the identified product" as being "IBM internal". Given that the disclosure document states that the product is to be "IBM internal", there is no reasonable basis for assuming that there were "any disclosures, publications, or sales information" that were external to IBM and available to parties other than IBM around the 08/18/1999 publication date of the applied reference.

Sixth, Applicant asserts that the 1.105 requirement for additional information in the Office action appears to be an exercise to obtain additional information that hypothetically might raise an additional issue of an on-sale bar to the patentability of the present invention or for some other similar issue. It should be self-evident that an attempt to obtain information in order to create an additional examination issue does not assist in the resolution of existing examination issues.

Seventh, Applicant asserts that the 1.105 requirement is so vague and unclear in its present form that Applicant is not able to comply with the requirement. Applicant cannot comply with the requirement in the Office action that Applicant "... present any disclosures, publications, or sales information that have been cited in the IBM Invention Disclosure on pages 3-4 ..." because no such information is cited. Applicant notes that the MPEP

requires that a 1.105 requirement should be "narrowly defined". Given that it is unclear what additional information Applicant could present to clarify the issues concerning the 08/18/1999 publication of the applied reference, Applicant requests a clarification of the requirement if the 1.105 requirement is maintained.

V. Applicant's Declaration as Evidence of Derivation of Work

MPEP 2132.01 states:

When the reference is not a statutory bar under 35 U.S.C. 102(b), (c), or (d), applicant can overcome the rejection by swearing back of the reference through the submission of an affidavit under 37 CFR 1.131. *In re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). If the reference is disclosing applicant's own work as derived from him or her, applicant may submit either a 37 CFR 1.131 affidavit to antedate the reference or a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

As discussed hereinabove, Applicant has submitted evidence that Applicant's conception of the claimed invention antedates the applied reference. In addition, **Applicant also asserts that it is unclear why the Office action has failed to consider that the pending obviousness rejection is improperly based on Applicant's own work.** The pending rejection in the outstanding

Office action is an obviousness rejection under 35 U.S.C. §103(a). Any reference that is applied in a rejection under 35 U.S.C. §103(a) must be qualified as a prior art reference under one of the sections of 35 U.S.C. § 102. The applied JSP 1.1 reference qualifies as prior art under 35 U.S.C. § 102(a) because the JSP 1.1 reference is a printed publication with a publication date prior to the filing date of the present patent application.

However, Applicant can overcome a rejection based on the JSP 1.1 reference because the JSP 1.1 reference is derived from Applicant's own work.

Applicant's previously submitted affidavit clearly contains
5 information sufficient to "to show derivation of the reference
subject matter from applicant and invention by applicant" as
stated in MPEP 2132.01. Although Applicant's previously
submitted affidavit is titled as a 1.131 affidavit and MPEP
2132.01 requests a 1.132 affidavit, a 1.132 affidavit is merely a
10 catch-all section that provides support for submission of
affidavits that are not otherwise "not provided for" in other
regulatory sections; thus, the title of the affidavit is relevant
to the other pending issues and irrelevant to the issue of
derivation of work. Hence, Applicant has properly submitted
15 evidence to rebut the *prima facie* case that the JSP 1.1 reference
describes work only "by others"; the JSP 1.1 reference clearly
describes work by Applicant as noted in paragraph #4 of the
affidavit and as acknowledged within the JSP 1.1 reference. In
other words, the relevant portions of the JSP 1.1 reference are
20 derived from Applicant's own work. Applicant asserts that the
burden of proof and/or the burden of production of evidence has
been shifted from Applicant back onto the Patent Office to
provide prove and/or to provide evidence that the JSP 1.1
reference is work only "by others" that does not include
25 Applicant. Without such a showing by the Patent Office,
Applicant asserts that the rejection has been overcome and that
the rejection should be withdrawn.

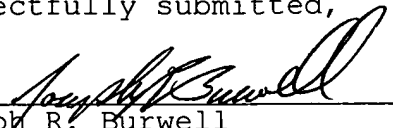
VI. Conclusion

30 It is respectfully urged that the present application is
patentable, and Applicant kindly requests a Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

5 DATE: January 27, 2005

Respectfully submitted,



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